UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,904	07/11/2003	Aditya Bhandarkar	13768.964.12	4899

47973   7590   06/01/2009
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EXAMINER
FISHER, PAUL R

ART UNIT	PAPER NUMBER
3689	

MAIL DATE	DELIVERY MODE
06/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	10/617,904	BHANDARKAR ET AL.
	Examiner	Art Unit	
	PAUL R. FISHER	3689	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>13 May 2009</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.

   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ They raise the issue of new matter (see NOTE below);

   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1,3-8,10,12-15 and 17-25*.

   Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Dennis Ruhl/
Primary Examiner, Art Unit 3689

 Continuation of 11. does NOT place the application in condition for allowance because: The Examiner has carefully reviewed and considered the applicant's arguments. The applicant has suggested in the overview of the invention that the key benefit of the invention is that the business process application is only deployed once, while partner attributes can be added and enlisted in an independent fashion. The applicant further suggested that the specification has support for this business process application being implemented using a programming language known as BPEL. The Examiner asserts that as previously stated BPEL is not mentioned in the applicant's specification and no support can be found for the very narrow definition of a business process the applicant wishes to use. While the specification does suggest that the business process execution engine can be implemented using XLANG scheduler engine it does not state BPEL. Also as stated by the applicant XLANG is different and distinct from BPEL since BPEL was created to replace XLANG and has additional functionalities that were not previously present in XLANG which reinforces the concept that the applicant did not have support for this material in their originally filed specification, as stated in the response to arguments of the Final rejection on March 13, 2009. The Examiner respectfully disagrees with the applicant's position that one of ordinary skill given the recited passages would interpret the term "business process" in the manor suggested by the applicant.

In response to the applicant's argument that there is support in the specification for "but that does not include business partner attributes," "subsequent to selecting the first business partner," and "subsequent to modifying the attribute and without recompiling the compiled business process application", the Examiner asserts that there is no support for the order in which these steps happen. The recited passages are referring to the conventional or known methods in which the invention is performed and merely stating that your method over comes a disadvantages of the conventional or known methods, without showing how it achieves this does not constitute as support for the implementation of the method. Further the sequence or when things take place in the method is not clear from the applicant's specification and is not present in the recited passages, for these reasons the Examiner maintains the 112 rejections and still considers the material new matter not supported by the originally filed specification.

In response to the applicant's argument that the claimed limitation is not indefinite, the Examiner respectfully disagrees. The currently recited limitation specifically that "the business process execution engine accessing a compiled business process application that includes selection criteria for selecting business partners but that does not include business partner attributes, the selection criteria indicating attributes that a business partner is to include to match the selection criteria" is indefinite. It is unclear to the Examiner how the selection criteria can be void of attributes but then indicate attributes. As previously asked by the Examiner is this to represent a template where performing searches, where the template has place holders to search for specific attributes? The applicant's response has failed to clarify this question or explain how the selection criteria can be void attributes but indicate attributes at the same time. For this reason the rejection is maintained.

In response to the applicant's argument that the Examiner has used the wrong definition and should have used the clear definition in the specification. The Examiner respectfully disagrees, no clear definition was provided to define the term "business process execution engine" or "compiled business process application" the Examiner has used definitions known in the art to define what a software engine is and what a compiled process is, since the applicant's originally filed specification has failed to clearly define these terms. Further the applicant's specification states that page 5, paragraph [18] "In one embodiment, business process execution engine is implemented with an XLANG Scheduler Engine" this does not disclose that "A business process execution engine is a specific type of engine that is used to execute business processes such as the XLANG Scheduler Engine of claim 25" as suggested by the applicant in the arguments submitted on May 13, 2009. Rather this shows that it can be used or implemented with or along with an XLANG Scheduler Engine and at no point does it show that the business process is an XLANG Scheduler Engine, they are shown to be two distinct processes. Since the applicant has provided no definition of the terms the Examiner asserts that the industry standard definitions are proper and therefore the rejections are maintained.

For the reasons set forth above all rejections are maintained and the arguments are considered to be non-persuasive.